

REMARKS

This Amendment is submitted in reply to the final Office Action mailed on September 7, 2007. A Request for Continued Examination ("RCE") is submitted herewith. The Director is authorized to charge the amount of \$810.00 for the cost of the RCE and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-306 on the account statement.

Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are pending in this application. Claims 2-3, 5, 12-13, 17 and 21-26 were previously canceled or withdrawn. In the Office Action, Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103. In response, Claims 6 and 16 have been canceled. Claims 1, 11, 27 and 32-33 have been amended. The amendments do not add new matter. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1, 4-10, 27-31 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,645,662 to Nakashima et al. ("*Nakashima*") in view of *Sturtz*. In view of the amendments and/or for at least the reasons set forth below, Applicants respectfully submit that the rejections be withdrawn.

Currently amended independent Claims 1, 27 and 33 recite, in part, a consumable oral product comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable oral product. The amendments do not add new matter. The amendments are supported in the specification at, for example, page 4, lines 12-23. In contrast, Applicants respectfully submit that there exists no reason why the skilled artisan would combine *Nakashima* and *Sturtz* to arrive at the present claims and, even if combinable, *Nakashima* and *Sturtz* fail to disclose each and every limitation of the presently claimed subject matter.

Applicants respectfully submit that not only does there not exist any reason to combine *Nakashima* and *Sturtz* to arrive at the present claims, the references teach away from same. For example, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the

reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998) (quoting *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994)).

In its attempt to arrive at the present claims by combining the cited references, the Patent Office has ignored significant portions of each reference that teach away from the combination and/or the present disclosure. For example, *Nakashima* is directed toward an oral composition for preventing and remedying dentinal hypersensitivity. See, *Nakashima*, Abstract. To effectively reduce sensitivity a soluble aluminum compound is used for constriction or occlusion of tubular orifices. However, the soluble aluminum compound causes a metallic and astringent taste to be incorporated into the oral composition. To reduce this metallic and astringent taste, *Nakashima* explicitly teaches incorporating the oral composition with l-menthol as a flavor agent. See, *Nakashima*, col. 8, lines 11-14. Moreover, *Nakashima* teaches away from *Sturtz* by encouraging incorporation of l-menthol as a flavor where the amount of l-menthol can be as much as 10% by weight. See, *Nakashima*, column 8, lines 30-35.

In contrast to *Nakashima*, *Sturtz* is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. See, *Sturtz*, col. 2, lines 29-32. Because *Nakashima* teaches significant amounts of l-menthol and *Sturtz* teaches a low menthol content, the references teach away from each other and the combination.

Consequently, Applicants respectfully disagree with the Patent Office’s assertion that “[a]lthough the primary reference, *Nakashima*, does encourage menthol as a flavor, the reference also discloses too much menthol can impart an excessive cooling taste.” See, Office Action, page 3, lines 3-8. As demonstrated above, however, *Nakashima* teaches that l-menthol may be incorporated into the product in an amount that is “as much as 10% by weight.” See, *Nakashima*, column 8, lines 30-35. Indeed, one of ordinary skill in the art would recognize that *Nakashima* teaches an amount of l-menthol that is much larger than the amount of l-menthol that is substantially absent in *Sturtz* and, therefore, teaches away from a combination with *Sturtz*.

Moreover, the Patent Office states that “[t]he claims recite the limitation cooling agents and although the instant disclosure defines cooling agents as non-menthol cooling agents, the claims give no indication that the menthol is excluded from the cooling agents or a recitation of cooling agents that are encompassed by the term cooling agents.” See, Office Action, page 3,

lines 8-11 (emphasis added). In contrast, however, to properly interpret claim language, the Federal Circuit has held that claims must be read in view of the specification, of which they are a part. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995). Moreover, intrinsic evidence in the form of the patent specification should guide claim construction. Along these lines, the Federal Circuit recently reinforced the importance of the specification when interpreting claim language:

[t]he claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term."

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005) (emphasis added). Therefore, since the specification clearly recites that "[c]ooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents," and in contrast to the Patent Office's statement, Applicants respectfully submit that there exists no question as to the definition of the phrase "cooling agents." See, Specification, Summary of the Invention (emphasis added). Although limitations in the specification cannot be incorporated into the claims, Applicants respectfully submit that the specification must be considered when determining how Applicants intended the phrase "cooling agents" to be interpreted. It is axiomatic that the Applicants' use of a term controls how that term is interpreted. Therefore, not only does *Nakashima* teach away from *Sturtz*, but *Nakashima* also teaches away from the presently claimed subject matter.

Applicants respectfully submit that in failing to consider the amount of l-menthol that is disclosed by *Nakashima*, and in failing to consider Applicants' definition of "cooling agents," the Patent Office has failed to consider those portions of *Nakashima* that teach away from the combination with *Sturtz* and that teach away from the present invention. Unless those portions of the art that teach away from the combination that is proposed are considered, Applicants respectfully submit that almost every invention would be obvious. Hence, the reason the courts have time and time again cautioned against such a hindsight analysis. Therefore, Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by

attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious.

In sum, Appellants respectfully submit that the Examiner continues to pick and choose selected portions of the cited references to arrive at the present claims. However, when the references are properly considered as a whole, the references teach against or away from the combination and/or from the claimed invention. As a result, the skilled artisan would have no reason to modify or combine the cited references to arrive at the present claims.

Nevertheless, Applicants also respectfully submit that, even if combinable, *Nakashima* and *Sturtz* do not disclose or suggest all of the elements of the presently amended independent Claims 1, 27 and 33 and the dependent claims that depend therefrom. For example, *Nakashima* and *Sturtz* fail to disclose or suggest a consumable oral product comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable oral product as required, in part, by independent Claims 1, 27 and 33. In fact, neither *Nakashima* nor *Sturtz* disclose any amounts of Erospicata oil in a confectionery product at any place in the disclosures.

For at least the reasons discussed above, the combination of *Nakashima* in view of *Sturtz* is improper or fails to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4-10, 27-31 and 33 be reconsidered and the rejections be withdrawn.

In the Office Action, Claims 1, 4-11, 14-16, 18-20, and 27-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,015,464 to Strobridge ("*Strobridge*") in view of *Sturtz*. In view of the amendments, and for at least the reasons set forth below, Applicants respectfully submit that the rejection be withdrawn.

Currently amended independent Claims 1, 11, 27, 32 and 33 recite, in part, consumable products comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable product. The amendments do not add new matter. The amendments are supported in the specification at, for example, page 4, lines 12-23. In contrast, Applicants respectfully submit that there exists no reason why the skilled artisan would combine *Strobridge* and *Sturtz* to arrive

at the present claims and, even if combinable, *Strobridge* and *Sturtz* fail to disclose each and every limitation of the presently claimed subject matter.

Applicants respectfully submit that the skilled artisan would have no reason to combine *Strobridge* and *Sturtz* to arrive at the present claims. Specifically, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. For example, *Strobridge* is directed toward anti-plaque chewing gums comprising anti-plaque properties. See, *Strobridge*, Abstract. Specifically, the gum must comprise an anti-plaque effective amount of eucalyptol, menthol, methyl salicylate and thymol. The menthol must be present in an amount from about 0.3 to about 2.1% and most preferably about 1.07%. Too little of the essential oils will render the product ineffective against plaque. See, *Strobridge*, col. 2, lines 38-52; col. 2, line 58-col. 3, line 2. In contrast, however, *Sturtz* is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. See, *Sturtz*, col. 2, lines 29-32.

Moreover, as discussed above, the present disclosure specifically states that “[c]ooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents.” See, Specification, Summary of the Invention (emphasis added). Therefore, not only does *Strobridge* teach away from *Sturtz*, but *Strobridge* also teaches away from the presently claimed subject matter.

Applicants respectfully submit that in failing to consider the amount of menthol that is required by *Strobridge*, and in failing to consider Applicants’ definition of “cooling agents,” the Patent Office has failed to consider those portions of *Strobridge* that teach away from the combination with *Sturtz* and that teach away from the present invention. Unless those portions of the art that teach away from the combination that is proposed are considered, Applicants respectfully submit that almost every invention would be obvious. Hence, the reason the courts have time and time again cautioned against such a hindsight analysis. Therefore, Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious.

In sum, Applicants respectfully submit that the Examiner continues to pick and choose selected portions of the cited references to arrive at the present claims. However, when the

references are properly considered as a whole, the references teach against or away from the combination and/or from the claimed invention. As a result, the skilled artisan would have no reason to modify or combine the cited references to arrive at the present claims.

Nevertheless, Applicants also respectfully submit that, even if combinable, *Strobridge* and *Sturtz* do not disclose or suggest all of the elements of the presently amended independent Claims 1, 11, 27, 32 and 33. For example, *Strobridge* and *Sturtz* fail to disclose or suggest a consumable product comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable product as required, in part, by independent Claims 1, 11, 27 and 32-33. In fact, neither *Strobridge* nor *Sturtz* disclose any amounts of Erospicata oil in a product at any place in the disclosures.

For at least the reasons discussed above, the combination of *Strobridge* in view of *Sturtz* is improper or fails to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4-11, 14-16, 18-20 and 27-33 be reconsidered and the rejections be withdrawn.

In the Office Action, Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0119231 to Kumamoto et al. ("*Kumamoto*") in view of *Sturtz*. For at least the reasons set forth below, Applicants respectfully submit that the rejections be withdrawn.

Currently amended independent Claims 1, 11, 27, 32 and 33 recite, in part, consumable products comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable product. The amendments do not add new matter. The amendments are supported in the specification at, for example, page 4, lines 12-23. In contrast, Applicants respectfully submit that there exists no reason why the skilled artisan would combine *Kumamoto* and *Sturtz* to arrive at the present claims and, even if combinable, *Kumamoto* and *Sturtz* fail to disclose each and every limitation of the presently claimed subject matter.

Applicants respectfully submit that the skilled artisan would have no reason to combine *Kumamoto* and *Sturtz* to arrive at the present claims. Specifically, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or

away from the claimed invention must be considered. For example, *Kumamoto* is entirely directed toward warming compositions that are incorporated into consumable products. See, *Kumamoto*, Abstract. In the Background of the Invention, *Kumamoto* repeatedly emphasizes that the invention is directed toward providing warming compositions that exhibit long-lasting warming effects.

In contrast, however, *Sturtz* is directed primarily toward a new and distinct variety of a mint plant, now known as Erospicata. See, *Sturtz*, Abstract. Erospicata can be used as a replacement to various cooling agents, including peppermint, to create a cooling composition without epithelial irritation caused by large amounts of menthol. Therefore, in contrast to *Kumamoto*, *Sturtz* is entirely directed toward providing cooling compositions. As such, the warming compositions disclosed by *Kumamoto* teach away from a combination with the cooling compositions of *Sturtz*, and the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

Applicants respectfully submit that unless those portions of the art that teach away from the combination that is proposed are considered, Applicants respectfully submit that almost every invention would be obvious. Hence, the reason the courts have time and time again cautioned against such a hindsight analysis. Therefore, Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious.

In sum, Applicants respectfully submit that the Examiner continues to pick and choose selected portions of the cited references to arrive at the present claims. However, when the references are properly considered as a whole, the references teach against or away from the combination and/or from the claimed invention. As a result, the skilled artisan would have no reason to modify or combine the cited references to arrive at the present claims.

Nevertheless, Applicants also respectfully submit that, even if combinable, *Kumamoto* and *Sturtz* do not disclose or suggest all of the elements of the presently amended independent Claims 1, 11, 27, 32 and 33. For example, *Kumamoto* and *Sturtz* fail to disclose or suggest a consumable product comprising Erospicata oil, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total

consumable product as required, in part, by independent Claims 1, 11, 27 and 32-33. In fact, neither *Kumamoto* nor *Sturtz* disclose any amounts of Erospicata oil at any place in the disclosures.

Moreover, Applicants also respectfully disagree with the Patent Office's statement that "*Kumamoto* cannot be teaching away from the instant claims because it discloses cooling agents may be used in conjunction with the warming agents, which encompasses the claims." See, Office Action, page 6, lines 11-13. Instead, *Kumamoto* teaches cooling agents that include menthol, which contradicts the teachings of the instant claims. Not only do the instant claims require cooling agents that are "non-menthol" cooling agents, but Erospicata is used as a replacement for the menthol commonly used in products like that of *Kumamoto*. Therefore, Applicants respectfully submit that *Kumamoto* does, in fact, teach away from the instant claims.

For at least the reasons discussed above, the combination of *Kumamoto* in view of *Sturtz* is improper or fails to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4-11, 14-16, 18-20 and 27-33 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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